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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/629,184	07/29/2003	Guy Beard	B0978.04U	7202
29633	7590	11/18/2004	EXAMINER	
ROGERS TOWERS, P.A. 1301 RIVERPLACE BOULEVARD, SUITE 1500 JACKSONVILLE, FL 32207			JIMENEZ, MARC QUEMUEL	
			ART UNIT	PAPER NUMBER

3726

DATE MAILED: 11/18/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

**Application No.**

10/629,184

**Applicant(s)**

BEARD, GUY

**Examiner**

Marc Jimenez

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 23 August 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-4,6-11 and 13-28 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 1-4,6,8-11,13-19,21 and 23-28 is/are allowed.
- 6) ☒ Claim(s) 7,20 and 22 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 29 July 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

## DETAILED ACTION

### *Allowable Subject Matter*

1. The indicated allowability of claim 7 is withdrawn in view of the newly discovered reference(s) to Kazuhiro et al. (EP 0 313 070 A2). Rejections based on the newly cited reference(s) follow.

### *Claim Rejections - 35 USC § 103*

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. **Claims 7, 20, and 22** are rejected under 35 U.S.C. 103(a) as being unpatentable over Kazuhiro et al. in view of Applicant's Admitted Prior Art [AAPA] (page 3-4 of applicant's specification) and Chia et al. (US 6,532,766).

Regarding claims 7 and 22, Kazuhiro et al. teach a method of manufacturing an article of jewelry comprising providing a wire 1 composed of between approximately 50 to 60 wt percent Ni (col. 3, lines 27-31) and between approximately 40 to 50 wt percent Ti (col. 3, lines 27-31), forming the wire 1 into a desired shape (figures 1-2(B) and col. 1, lines 9-15), elevating the temperature (col. 4, lines 39-40) of the wire 1 above the austenite phase finish temperature (col.

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3m line 41) to impart a memory shape to the wire 1, and assembling the wire with other components (col. 4, lines 16-23).

Kazuhiro et al. teach the invention cited with the exception of cooling the wire below martensite phase finish temperature and laser welding the wire to the components.

[AAPA] teaches cooling a wire below martensite phase finish temperature by rapidly cooling the heated wire.

Chia et al. teach laser welding as a method of attaching components to jewelry articles (col. 18, lines 25-28).

It would have been obvious to one of ordinary skill in the art, at the time of the invention, to have provided the invention of Kazuhiro et al. with cooling the wire below martensite phase finish temperature; in light of the teachings of [AAPA], in order to impart the shape memory effects that is inherent in shape memory alloys.

Furthermore, it would have been obvious to one of ordinary skill in the art, at the time of the invention, to have provided the invention of Kazuhiro et al./[AAPA] with laser welding to attached the components to the wire, in light of the teachings of Chia et al., in order to securely fasten the components to the wire.

Regarding claim 20, note that Kazuhiro et al. teach using a mandrel in the forming step (col. 5, lines 10-11).

Regarding claim 22, both Kazuhiro et al. and [AAPA] describe heat treating steps.

***Allowable Subject Matter***

4. Claims 1-4, 6, 8-11, 13-19, 21, and 23-28 allowed.

***Response to Arguments***

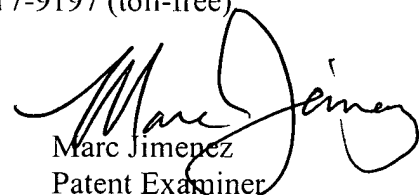
5. Applicant's arguments with respect to claims 7, 20, and 22 have been considered but are moot in view of the new ground(s) of rejection.

***Contact Information***

6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Marc Jimenez whose telephone number is (703) 306-5965. The examiner can normally be reached on Monday-Friday between 5:30 a.m.-2:00 p.m..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Peter Vo can be reached on (703) 308-1789. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

  
Marc Jimenez  
Patent Examiner  
AU 3726

**MJ** November 13, 2004